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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,296	09/16/2003	Hong Ying Wang	50103-569	9800

49745 7590 06/16/2005
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EXAMINER

BERNATZ, KEVIN M

ART UNIT PAPER NUMBER

1773

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/662,296

Applicant(s)

WANG ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: applicants arguments have been considered, but have not been deemed persuasive.

Specifically, with regard to Ishida et al., applicants argue that Ishida et al. does not disclose an embossing surface "formed of platinum, carbon, a polycarbonate, a polyetherimide, a polypropylene, or a polyethylene", further asking the Examiner to explicitly identify where the Examiner deems that Ishida et al. does disclose such a limitation.

For the material, the Examiner notes that Ishida et al. disclose preferred embodiments of the master information carrier comprising a multi-layered structure including polypropylene (col. 21, line 44 bridging col. 22, line 14). While the example disclosed on col. 23 (lines 1 - 28) utilizes a structure wherein only the ferromagnetic material is formed in the shape of servo patterns, the Examiner noted in the rejection of record that Ishida et al. clearly disclose that many structures can be used to provide the servo patterning, including patterning the substrate, patterning the substrate and the ferromagnetic layer, or just the ferromagnetic layer (e.g. Figures 2 - 4). Since a reference is good for its entire teachings and not just the disclosed examples, the Examiner maintains that Ishida et al. disclose a master information carrier wherein the embossing surface includes a negative image of the servo pattern and wherein the embossing surface is formed of at least polypropylene (i.e. a hydrophobic polymer).


Applicants further argue that Takeoka et al. fail to teach the same limitation. The Examiner notes that part of the confusion may stem from a typographical error in the column + line citation used with regard to claim 16, but the Examiner notes that the column + line citation used for dependent claims 21 and 23 (which further limit the embossing surface) clearly indicate from where the Examiner was drawing the disclosed limitation. The Examiner will address the argument regarding the scope of "embossing surface is formed of" below.

Regarding the rejection predicated on Zager et al., in addition to similar arguments presented above, applicants have disagreed with the Examiner's combination of the Zager et al. teaching regarding the stamper + medium. The Examiner respectfully disagrees.

The Examiner acknowledges combining the embodiments of the medium (for choice of substrate materials) and the stamper (for structure), however the Examiner notes that Zager et al. explicitly teach combining such embodiments on col. 10, lines 65 - 67. As such, the Examiner deems that utilizing the teaching of which substrate materials are acceptable is within the knowledge of one of ordinary skill reading the teachings of the Zager et al. reference.

Finally, the Examiner notes that it appears that the primary argument through-out applicants' response is the scope afforded the language "said embossing surface is formed of" in claims 16 and 23. Regarding this limitation, the Examiner has given the term(s) the broadest reasonable interpretation(s) consistent with the written description in applicants' specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Donaldson Co., Inc.*, 16 F.3d 1190, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994). See MPEP 2111. Specifically, "embossing surface" has never been defined by applicants to mean only the outermost layer of the stamper. The claims recite a "main body having an embossing surface", which the Examiner has interpreted as meaning that the main body has two surfaces, one of which is used facing the recording media (i.e. the embossing surface) and the other which faces away from the medium (e.g. the back side of the stamper). This "embossing surface" can comprise multiple layers (as taught in the prior art) and still read on "a main body having an embossing surface". The further limitation of "formed of" is open language, and hence also open to the existence of other layers being present.

The Examiner suggests considering the utilization of language which positively recites that the "embossing surface" is actually a single layer, such as clarifying that the embossing surface is the "patterned surface" layer of the stamper which directly contacts the surface of the sol-gel (see pages 7 - 8 of specification) or that the "embossing surface" consists of the recited materials, thereby excluding additional layers from being on that side of the main body.


Kevin M. Bernatz, PhD
Primary Examiner